

In line 10, delete "one," after "said" insert —one—, and after "side" delete "along a";

In line 11, after "frame" insert —and having projected in said positioning recess a vertical strip—;

In line 13, delete "B." and insert —C.—; and

In line 16, delete "D." and insert —E.—.

Enclosed is a marked up version of claim 1 and a clean copy thereof.

Reconsideration of the rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Holzworth in view of Ide is respectfully requested for the reasons which follow.

The disclosure of Holzworth in column 6, lines 57-66 only goes so far that it was acknowledged it leaves undisclosed "a semi-spherical configuration being positioned on a vertically oriented rectangular strip." The "rectangular strip" being the structural feature of a door frame which "normally [serves] as a stop for a pivotal transverse of a door mounted in [a] doorway "and the manner in which the positioning is achieved being recited in amended claim 1.

The Examiner contends that it would be obvious to modify the Holzworth's device, i.e., presumably to use the door stop and a positioning notch now recited in amended claim 1, contending it is taught by Ide (underlining added). Ide, however, does not make up for the anticipating disclosure acknowledged to be lacking in Holzworth but even more pertinent, in establishing a prima facie case of obviousness, it is incumbent up the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem

from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert.denied, 488 U.S. 825 (1988).

It is clear that in Holzworth it was only as an aside that reference was made to a "door frame" and that it provides "support for the rear 25 of base member 20." The fact that the Holzworth device could be modified as now recited in claim 1 does not make such a modification obvious in the absence of the prior art suggesting the desirability of doing so (In re Gordon 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 984)). Here, the examiner has provided no clue as to where support is found for the reasoning set forth as the suggestion to combine the references, and therefore it stands merely as the examiner's unsupported opinion. This being the case the question arises as to why one of ordinary skill in the art would attach such importance to the aside of Holzworth as to substitute a wedge, not normally used in a door frame, by a stationary semi-spherical device 12 of Ide, not used at all in a door frame but on a surface area 4, that is, what advantage would be gained? Applicant finds none expressed in the references, and it thus would appear that the only motivation for doing so is found in the hindsight afforded one who first viewed applicant's disclosure. This, of course, is not a proper basis for a rejection under Section 103.